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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,165	11/14/2003	Krishnan Chari	85500KNM	9809

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Paul A. Leipold
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

EXAMINER

GROSS, CHRISTOPHER M

ART UNIT	PAPER NUMBER
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1639

MAIL DATE	DELIVERY MODE
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05/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/713,165	Applicant(s) CHARI ET AL.	
	Examiner Christopher M. Gross	Art Unit 1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-12, 20, 21, 25 and 30-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-19, 22-24, 26-29 and 34 is/are rejected.
- 7) ☒ Claim(s) 25-27, 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/12/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Responsive to communications entered 2/12/2007 Claims 1-34 are pending. Claims 1-12,20,21,25,30-33 stand withdrawn. Claims 13-19,22-24,26-29,34 are examined herein.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

Applicant's election without traverse of group II (claims 13-24, 26-29) and the species: "CD-1," structure shown on page 9 of the specification from claim 13; "glass" from claim 17; "100-1000000" from claims 19-21; "chemical" from claims 25-26 in the reply filed on 8/3/2006 is acknowledged. A telephone call to Lynne Blank on 8/22/2006 completed the species election with "nucleic acid" from claim 27.

The examiner regrets any confusion regarding the status of the claims, which is summarized as follows:

Claims 1-12, 25 are directed to a coating composition and stand withdrawn pursuant to 37 CFR 1.142(b) as being drawn to nonelected invention I.

Claims 30-31 are directed to a method of making a microarray and stand withdrawn pursuant to 37 CFR 1.142(b) as being drawn to nonelected invention III.

Claims 32-33 are directed to a microsphere composition and stand withdrawn pursuant to 37 CFR 1.142(b) as being drawn to nonelected invention IV.

Claims 13-24,26-29,34 are directed to the microarray of elected invention II. Claims 20-21 are directed to various microsphere concentrations of invention II and stand withdrawn pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species.

Therefore, claims 13-19,22-24,26-29,34 are under consideration.

Priority

This application has a filing date of 11/14/2003. Applicant makes no claim for the benefit of any prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c).

Specification

The amendment filed 2/12/2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

“a dye for coloring microspheres cyan with colorant materials that have the property of very low fluorescence intensity such that the resultant colored microspheres do not substantially fluoresce when excited by visible light.”

Support for cyan colored microspheres which do not substantially fluoresce when excited by visible light is not found in the disclosure as originally filed.

Applicant is required to cancel the new matter in the reply to this Office Action.

Maintained Claim Rejection(s) - 35 USC § 102

Claims 13-15,17-19,22-24,28 and 29 rejected under 35 U.S.C. 102(b) as being anticipated by Bagchi et al (US Patent 5,055,379).

Response to Arguments

The declaration under 37 CFR 1.132 filed 2/12/2007 is insufficient to overcome the rejection of claims 13-15,17-19,22-24,28 and 29 based upon Bagchi et al under 35 USC 102 (b) as set forth in the last Office action because:

Applicant argues, see p 10-12 (Remarks, 1/3/2007) that Bagchi et al do not teach all elements and in accompanying said declaration under 37 CFR 1.132, applicant asserts that many of dyes according to Bagchi et al do not have the property of not exhibiting substantial fluorescence when excited by visible light, as set forth in amended claim 13.

It is noted, however, that said declaration (i) does not provide any indication as to the excitation wavelength used; (ii) does not provide a fluorescence excitation scan across the full range of visible light; (iii) does not provide a fluorescence spectrum of the cyan dye, with structure shown in column 41 according to Bagchi et al.

The excitation wavelength is necessary to judge whether the presented evidence (i.e. the fluorescence emission spectra) was excited by light in the visible range. A fluorescence excitation scan is necessary to judge whether the presented evidence (i.e. the fluorescence emission spectra) covers the entire range of visible light. The cyan dye according to Bagchi et al lies in the Markush group set forth in claim 13 and was not analyzed.

In conclusion, applicant's arguments and evidence is not commensurate in scope with the claims. See MPEP § 716.

Maintained Claim Rejection(s) - 35 USC § 103

Claims 13-15,17-19,22-24,28, 29 and 16, 26,27 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bagchi et al** (US Patent 5,055,379) in view of **Chrisey et al** (1996 Nucleic Acids Research 24:3040-3037)

Response to Arguments

Applicant argues (i) not all elements are taught; (ii) that Chrisey et al represents non-analogous art

Applicants arguments have been considered but they are not persuasive for the following reasons.

(i) Applicant does not offer further arguments see p 13 (2/12/2007) regarding the above obviousness rejection beyond what was set forth with regard to the 35 U.S.C. § 102 rejection. To the extent that Applicant is merely repeating his previous argument, the Examiner contends that those issues were adequately addressed in the above sections, which are incorporated in their entireties herein by reference.

(ii) Applicant specifically argues, see (Remarks, 2/12/2007) p 13 4th full paragraph, line 5 that the teaching of Chrisey et al is not related to microarrays, however Applicant's attention is respectfully invited to the first sentence on page 3040, of Chrisey et al concerning 'biochip assays' The Examiner submits that biochips are synonymous with microarrays.

Claims 13-15,17-19,22-24,28, 29 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bagchi et al** (US Patent 5,055,379).

Applicant argues see p 14 (2/12/2007) that there is no teaching in Bagchi et al directed to which dyes do not substantially fluoresce when excited by visible light.

It is noted, however that the claim 13 is drawn to a composition comprising microspheres that do not substantially fluoresce when excited by visible light. Therein, the open language of the claim(s) may include microspheres, which do substantially fluoresce when excited by visible light, and thus applicant's argument is not commensurate with the scope of the claim.

Additionally, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a composition consisting of microspheres which do not substantially fluoresce when excited by visible light) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

New Claim Objections

Claims 25,26,27 are objected to in having incorrect status identifiers. Claim 25 stands "withdrawn." Claims 26, 27 should be indicated as "original."

Claim 34 is objected to for having a duplication of the structure of CD-1.

New Claim Rejections - 35 USC § 112

The following is a quotation of the **first** paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13-19,22-24,26-29,34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. 37 CFR 1.118 (a) states that "No amendment shall introduce new matter into the disclosure of an application after the filing date of the application".

This rejection is necessitated by Applicant's amendment to the claims.

Claim 13 has been amended to insert the limitation microspheres "that do not substantially fluoresce when excited by visible light"; the microspheres containing a dye represented by formula (I).

While it is noted that according to p 8 line 15 of the present specification halogen substitution at R1 of the quinoneimine portion provides the property of extremely low fluorescence, the Markush group set forth in claim 13 includes species for which said substitution is not made and the disclosure does not provide any implicit or explicit support for which of the claimed non-halogenated species possess the said fluorescence property.

Additionally, the disclosure does not provide any implicit or explicit support for which species do not substantially fluoresce when excited by [with full range of] visible light.

Applicants are reminded that it is their burden to show where the specification supports any amendments to the claims. See 37 CFR 1.121 (b)(2)(iii), the MPEP 714.02, 3rd paragraph, last sentence and also the MPEP 2163.07, last sentence.

MPEP 2163.06 notes "If new matter is added to the claims, the examiner should reject the claims under 35 U.S.C. 112, first paragraph - written description requirement. *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981)." MPEP 2163.02 teaches that "Whenever the issue arises, the fundamental factual inquiry is whether a claim defines an invention that is clearly conveyed to those skilled in the art at the time the application was filed...If a claim is amended to include subject matter, limitations, or terminology not present in the application as filed, involving a departure from, addition to, or deletion from the disclosure of the application as filed, the examiner should conclude that the claimed subject matter is not described in that application. MPEP 2163.06 further notes "When an amendment is filed in reply to an objection or rejection based on 35 U.S.C. 112, first paragraph, a study of the entire application is often necessary to determine whether or not "new matter" is involved. *Applicant should therefore specifically point out the support for any amendments made to the disclosure.*

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

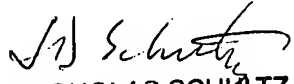
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Gross whose telephone number is (571)272-4446. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. Douglas Schultz can be reached on 571 272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher M Gross
Examiner
Art Unit 1639

cg


J. DOUGLAS SCHULTZ, PH.D.
SUPERVISORY PATENT EXAMINER